



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,077	11/27/2001	Jeffry J. Grainger	021737-000710US	1100
20350	7590	09/18/2008	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			RUHL, DENNIS WILLIAM	
TWO EMBARCADERO CENTER				
EIGHTH FLOOR			ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94111-3834			3689	
			MAIL DATE	DELIVERY MODE
			09/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/996,077	GRAINGER, JEFFRY J.
	Examiner	Art Unit
	Dennis Ruhl	3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 May 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

Applicant's response of 5/23/08 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,13, it is not clear as to whether or not the claim requires a step of preparing a patent application and also the filing the patent application. There is claim language directed to sending a message that indicates a request for an approval of a patent application, or that there is a message that requests one to prepare a patent application. The examiner notes that the claim never actually recites that the patent application is approved or even prepared. In view of the fact that the claim does not recite a patent application preparation or approval, one wishing to avoid infringement would not be clear on whether or not these steps are required, which relates to the language about the patent application and the due dates. If applicant is going to recite that a patent application is associated with the database, and that a due date is determined based on the filing date of the patent application, then the steps of preparing the patent application and filing the patent application have to be claimed; otherwise, it is not clear as to whether or not these steps are actually required in the claim scope.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (6584466) in view of Simpson et al. (6549894).

For claims 1,8,9,10,13,14,15,17, Serbinis discloses a document management system that allows a document originator to upload a document to a server system so that other users of the system may access the document to review and/or modify the document. Also disclosed is that the system can track workflow and can track various tasks that are to be completed in a particular order, where notification of a task needing to be performed includes a preset date and time for the notification to be sent. Serbinis recognizes that the message itself that is related to a particular task needing to be performed may need to be sent at a particular time, which would relate to due dates for various tasks to be performed. The claimed step of storing a first workflow rule in a server system is satisfied in Serbinis by the disclosure that the system 17 can provide a workflow service. Upon receipt of a document from an originator, the system generates a notification to other users informing them that the document is now available for review. See column 5, lines 26-34; column 6, line 64 to column 7, line 3; column 7, lines 50-62; column 9, lines 9-32. See column 9, line 49-column 10, line 23. It is disclosed that upon receipt of a document the system sends a message to other user(s) informing them that the document is available for review. With respect to the claimed

step of storing the invention disclosure (interpreted as a document) in a database, this is disclosed by Serbinis. Serbinis discloses that the documents are stored in a database 30. The claimed step of associating the invention disclosure with a case data unit in the database is deemed to be satisfied by the fact that in Serbinis, the various documents are stored in a database that associates file names and other various document related data to the actual stored document. The case data unit can be interpreted to be a file name or even any of the information that is stored when a relational database is used.

See column 5, lines 35-line 62 for a discussion of the database and the various information that is stored therein. The stored document is associated with all of the stored data. With respect to the claimed step of receiving by the server a signal indicating a request to submit the invention disclosure for approval and the execution of message generation, this is seen as being satisfied by the fact that upon receipt of a document from an originator, the system generates a notification to other users informing them that the document is now available for review. This happens in response to receipt of the document. With respect to the tracking of elapsed times as claimed in the Markush grouping, applicant is referred to column 13, lines 51-57. The system of Serbinis tracks the various times of completion of various events and stores this data. Also disclosed is that the time of notification to a user is recorded and any events related to the document are stored, which includes the timestamp for the various events, for example see column 8, line 38 for the timestamp.

With respect to the recitation that the message has a message content that requests approval to prepare a patent application, and the fact that the claim is directed

Art Unit: 3689

to the use of documents that are patent application documents, this is not taught by Serbinis. The examiner notes that Serbinis discloses three examples of different types of documents that the system can be used with. In column 9, lines 9-18, it is disclosed that the document can be a business plan for a startup company. In column 10, lines 51-54, it is disclosed that the documents can be a book that is electronically distributed via the system of Serbinis. In column 14, lines 20-29 it is disclosed that the document management system of Serbinis can be used by a lawyer for clients and their documents. These three examples are showing that the system of Serbinis can be used for any kind of documents that one desires. The type of documents that one uses the system of Serbinis with is a choice that would have been obvious to one of ordinary skill in the art and is something that does not involve more than ordinary skill in the art. One could use the system for documents related to sports, books, legal documents, movie reviews, draft reports, etc.. The kind of document that the system is used with can and will vary depending on whether it is used for a business plan for a company, for a book, or for a lawyer practicing law. With respect to the use of the system by a lawyer, it is very well known to one of ordinary skill in the art that lawyers work on patent applications for inventors, the examiner takes official notice of this fact. A part of the law that a lawyer may practice and that is covered in law school includes intellectual property and patents. With respect to the use of the system for patent application documents and invention disclosures, it would have been obvious to one of ordinary skill in the art to use the system of Serbinis for any kind of documents, including for patent application documents when used by a lawyer practicing patent law. If Serbinis

contemplated the use of the system for lawyers, then arriving at using the system for patent application documents would have been obvious to one of ordinary skill in the art because this is just one area of the law that a lawyer may work in and is an area that is very well known in the art to one of ordinary skill. This then results in a patent application being associated with the case data unit, which is the original document received into the system. The kinds of messages then generated by the system are those that would naturally flow from the fact that the documents are patent documents, such as messages relating to submitted specifications before they are filed (preparation, drafting preparation, etc.) and after they are filed (office actions, amendments, etc.). The content of the message itself is really non-functional descriptive material but the examiner has given full weight to the language because it is considered obvious anyway.

Not disclosed by Serbinis is that a first due date for a foreign filing is calculated based on a filing date of a patent application, and that the due dates are maintained in a docketing system, and that a reminder is sent to a client system. Simpson discloses a computer system that is used for intellectual property law (patents). Simpson discloses that it is known in the art to track various due dates that are related to patent prosecution and send out reminders to individuals responsible for due date compliance. See column 1, line 31-column 2, line 57. Also specifically see column 2, line 15 and 16 where it is disclosed that a foreign filing letter is sent to a client and that "Foreign file before deadline to receive priority filing date" is disclosed. Column 3, lines 4-27 discloses that systems are known that can calculate due dates for various actions that

need to be done by various due dates. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Serbinis with the ability to calculate due dates for patent application related matters and to also send out reminders to individuals as claimed. The examiner has already addressed the use of the system of Serbinis with patent documents and Simpson discloses the use of a computer system to calculate due dates for patent documents, so one of ordinary skill in the art at the time the invention was made would have found it obvious to have the system of Serbinis calculate a due date for a foreign filing of an application, which is disclosed by Simpson. When one is using the system of Serbinis for patent related documents, the issue of filing in a foreign country as of a particular due date is something that would naturally arise as a result of the fact that you are dealing with patents.

For claim 2, the content of the message is considered to be directed to non-functional descriptive material that is merely descriptive in nature. What the message says is not considered to be functional material. Also, reciting that "when read", the message allows for something to occur, this is not a positive recitation of another step occurring. This is not a recitation that the message is actually read by anyone and it is not a recitation to anyone approving or disapproving anything. The prior art satisfies what is claimed.

With respect to claim 3, Serbinis discloses that when various tasks are completed, this fact is noted by the system and is stored in the system as an event relating to the document. The generation of the message is satisfied by the fact that

when a tasks is completed in Serbinis (which can be a review or preparation of a document, a tasks that needed completion), this is noted and a message can be generated to inform the originator that the tasks has been completed. When the invention is used for patent documents as has already been addressed, he kinds of messages generated by the system are those that would naturally flow from the fact that the documents are patent documents, such as messages relating to submitted specifications before they are filed (preparation, drafting preparation, etc.) and after they are filed (office actions, amendments, etc.). The examiner takes the position that the content of the message is directed to non-functional descriptive material and that when the system is used for patent related documents, the kind of message recited is one that would naturally flow from the use of the system for patent documents as has already been addressed by the examiner.

With respect to claim 4, depending on how many authorized users are designated as having access rights to the stored documents for the completion of various tasks, and when there is more than one authorized user, sending the message of claim 3 to a third party, such as another authorized user of the document that is next in line to complete a task, is disclosed in column 10, lines 23-35. The fact that it is a law firm is non-functional descriptive material and is something that would flow from the use of the system by lawyers practicing patent prosecution.

For claim 5, the claimed user groups are the groups of authorized users that are granted access to various stored documents. Access rights are disclosed in column 6,

lines 34-46 for example. The software of Serbinis does what is claimed as far as designating authorized user groups and providing them access to the store documents.

For claims 11,12, see column 1, lines 36-42, and column 1 line 63- column 2 ,line 9. While this is disclosed in the disclosure of Serbinis, it is done so by a reference to background art. If one did not conclude that this was disclosed by Serbinis in an anticipatory sense, in view of the background art teachings, it would have been obvious to provide Serbinis with a message that included a link(s) as claimed so that the document could easily be accessed via the link. This is already something that is known in the art as evidence by Serbinis and the discussion regarding background art, so to provide it to Serbinis would have been obvious to one of ordinary skill in the art.

For claim 16, Serbinis allows more than one party to store a document in the database, and the issue of the documents being patent applications and related documents has already been addressed. The system of Serbinis is fully capable of sending a document to another entity as claimed. The recitation that it is a patent office is noted but is directed to non-functional descriptive material. Simply clicking on an email send button reads on what is claimed. The submit icon can be a button that sends a document to another person, this ability is found in Serbinis.

For claim 18, the claimed step of receiving information about a payment status and displaying the claimed information is satisfied by Serbinis due to the fact that it is disclosed that there is an administrative account feature that allows one to review an account and any account activity, see column 6, lines 57-63. Also see column 14, lines 20-30 for a teaching of accounting and billing features that stores information relating to

billing and finances for a lawyers clients. A user can view their account information and this includes information on billings and payments. With respect to the language about the displaying of a filing status and a payment status as well as the "invention disclosure award", this is directed to non-functional descriptive material. The type of information displayed is also considered something that flows from the teachings of the prior art when Serbinis used for patent documents (the filing status).

For claims 6,7, the language reciting that the client system is associated with a first technology developer, this is directed to non-functional descriptive material. The recitation to an association really does not mean anything specifically structurally or method stepwise and any user that ever has used a computer can be considered to be associated with that system. In Serbinis the various authorized users that are designated by the originator satisfy what is claimed with respect to different user groups. The claim reads on Serbinis having various authorized users perform certain tasks in a predefined order and the system informing them of the fact that it is now their turn to perform their task. The workflow rules are initially set up which satisfies what is claimed. It is initially defined and entered into the system by use of a "work station" (a computer).

5. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689